



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/074,472 05/07/98 RICHTER

M 337462000600

GLADYS H MONROY  
MORRISON & FOERSTER  
755 PAGE MILL ROAD  
PALO ALTO CA 94304-1018

HM22/0811

EXAMINER

CHAKRABARTI, A

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

08/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/074,472

Applicant(s)

Richter et al

Examiner

Arun Chakrabarti

Group Art Unit

1655



☒ Responsive to communication(s) filed on May 7, 1998 and Dec 13, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1655

### **DETAILED ACTION**

The art unit designated for this application has changed. Applicant (s) are hereby informed that future correspondence should be directed to art unit 1655.

#### ***Sequence Rules***

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotides and/or amino acid sequences set forth in 37 CFR 1.821 (a) (1) and (a) (2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because of the errors listed on the attached RAW SEQUENCE LISTING ERROR SUMMARY. Applicants are given the same response time regarding this failure to comply as that set forth to this office action.

#### ***Specification***

2. The numbering of claims is not accordance with 37 C.F.R. 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Art Unit: 1655

Misnumbered claims 25-28 have been renumbered 24-27 respectively.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected over the recitation of the phrase "A method for detecting an analyte" in the preamble. It is indefinite and vague to only "detect the analyte" without mentioning whether it is quantitative or qualitative.

Claim 1 is also rejected over the use of the word "ECL". It is vague and indefinite to use an abbreviated word without properly explaining the abbreviation in the preamble.

4. Claims 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 24-27 recites the limitation "assay reagent comprising an ECL quenching moiety".

There is insufficient antecedent basis for this limitation in the claim and therefore makes the claim

Art Unit: 1655

vague and indefinite. The phrase "an ECL quenching moiety" does not point specifically to the claim 1 moiety and may be confusingly interpreted as "any" such moiety.

***Claim Rejections - 35 USC § 102***

4. Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber et al (U.S. Patent 4,293,310) (October 6, 1981).

Weber expressly teaches an ECL (electrochemiluminescence) label and the ECL quenching moiety and instructions to use them (Column 3, line 61- Column 4, line 58) for the electrochemiluminescence assay. In this context, it is noteworthy that "electrochemiluminescence" and "photoelectrochemical" are synonym because the scientific principles and theories which form the basis of these assays are basically same. This rejection is being applied due to the above summarized unclarity as to whether claims 24 and 25 require the claim 1 quenching moiety or not.

5. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Sigma Chemical Company (Catalog 1995).

Sigma catalog expressly teaches the reagents containing benzene moiety (pages 151 and 1820) including phenol (page 789) and benzene carboxylic acids (Page 151).

Art Unit: 1655

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26 and 27 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Weber (U.S. Patent 4,293,310) (October 6, 1981) in view of Stratagene Catalog (1988, Page 39).

Weber expressly teaches the claims 24 and 25 as described above in detail.

Weber does not teach the motivation to combine all the reagents for detecting an analyte in a sample in the form of a kit.

Stratagene catalog teaches a motivation to combine reagents into kit format (page 39).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to combine a suitable container, ECL label and ECL quenching moiety of Weber into a kit format as discussed by Stratagene catalog since the Stratagene catalog teaches a motivation for combining reagents of use in an assay into a kit, "Each kit provides two services: 1) a variety of different reagents have been assembled and pre-mixed specifically for a defined set of experiments. Thus one need not purchase gram quantities of 10 different reagents, each of which is needed in only microgram amounts, when beginning a series of experiments. When one considers all of the unused chemicals that typically accumulate in weighing rooms, desiccators,

Art Unit: 1655

and freezers, one quickly realizes that it is actually far more expensive for a small number of users to prepare most buffer solutions from the basic reagents. Stratagene provides only the quantities you will actually need, premixed and tested. In actuality, the kit format saves money and resources for everyone by dramatically reducing waste. 2) The other service provided in a kit is quality control". (page 39, column 1).

Request to resubmit IDS due to its being misplaced at the PTO.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/074472

Page 7

Art Unit: 1655

*Arun Chakrabarti*

Arun Chakrabarti

August 10, 1999

*Ardin H. Marschel*

**ARDIN H. MARSCHEL  
PRIMARY EXAMINER**